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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/011,020	12/04/2001	Wolfgang Baltes	10018075	7582

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EXAMINER	
PHAM, TITO QUANG	
ART UNIT	**PAPER NUMBER**
2616	

DATE MAILED: 04/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/011,020	BALTES, WOLFGANG	
	Examiner	Art Unit	
	Tito Pham	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 January 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1, 2, 4, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huotari et al. (US Pub. 2002/0004935 A1) (hereinafter Huotari) in view of Owens (US Pub. 2003/0053443 A1).

- With respect to claim 1, Huotari discloses a method of automatically providing configuration information for a communication device (figures 2 & 3), said method comprising:

a) receiving a communication via a communication link (paragraph 68 lines 1-2);

b) identifying a source of said communication (paragraph 68 lines 3-5);

c) based on said source of said communication, determining configuration information for said communication device (paragraph 68 lines 6-9); and

d) sending said configuration information over said communication link; wherein said configuration information is automatically provided (paragraphs 51 and 68).

Huotari does not teach the communication is automatically generated and not requiring any user interaction or user entered information. However, Owens discloses a method of automatic connecting and provisioning for an DSL modem (paragraph 18).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include in Huotari a step of automatic connecting from the client device for the purpose of having a true Plug and Play device and saving time and money (Owens paragraph 33).

- Regarding claim 2, all limitations in the parent claim are disclosed above. Huotari further shows communication is via dial-up communication link (paragraph 51).
- Regarding claim 4, all limitations in the parent claim are disclosed above. Huotari further discloses determining configuration information using a product identifier for communication device, the product identifier provided in the communication (figure 3, paragraph 72).

- Regarding claim 6, all limitations in the parent claim are disclosed above. Huotari further discloses scanning a plurality of databases for configuration information for said communication device (figure 3, paragraph 66).

4. Claims 1, 3, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dieterman et al. (US Pat. 6,560,704) (hereinafter Dieterman) in view of Owens (US Pub. 2003/0053443 A1).

- With respect to claims 1 and 3, Dieterman discloses a method of automatically providing configuration information for a communication device (figures 1 & 2), said method comprising:

a) receiving a communication via a communication link (column 3 lines 1-2, column 4 lines 2-3, claim 1 element 1);

b) identifying a source of said communication (column 3 lines 27-29, claim 1 element 2), and utilizing a telephone caller identification function to identify source of said communication (column 4 lines 14-16, claim 1 element 2)

c) based on said source of said communication, determining configuration information for said communication device (column 4 lines 38-41); and

d) sending said configuration information over said communication link; wherein said configuration information is automatically provided (column 4 lines 60-64).

Dieterman does not teach the communication is automatically generated and not requiring any user interaction or user entered information. However, Owens discloses a method of automatic connecting and provisioning for a DSL modem (paragraph 18).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include in Huotari a step of automatic connecting from the client device for the purpose of having a true Plug and Play device and saving time and money (Owens paragraph 33).

- Regarding claims 1 and 5, Dieterman discloses a method of automatically providing configuration information for a communication device (figures 1 & 2), said method comprising:

  a) receiving a communication via a communication link (column 3 lines 1-2, column 4 lines 2-3, claim 1 element 1);

  b) identifying a source of said communication (column 3 lines 27-29, claim 1 element 2), and identifying a geographic region of the source of communication (column 3 lines 34-43, column 4 lines 41-44);

  c) based on said source of said communication, determining configuration information for said communication device (column 4 lines 38-41) based on the geographic region (column 4 lines 60-64); and

  d) sending said configuration information over said communication link; wherein said configuration information is automatically provided (column 4 lines 60-64).

Dieterman does not teach the communication is automatically generated and not requiring any user interaction or user entered information. However, Owens discloses a method of automatic connecting and provisioning for a DSL modem (paragraph 18).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include in Huotari a step of automatic connecting from the client device for the purpose of having a true Plug and Play device and saving time and money (Owens paragraph 33).

5. Claims 7-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huotari et al. (US Pub. 2002/0004935 A1) (hereinafter Huotari) in view of Dieterman et al. (US Pat. 6,560,704) (hereinafter Dieterman).

- With regards to claims 7, 15, and 16, Huotari discloses a system of configuring a broadband device, the process in the system comprises: identifying a source of said communication; determining configuration information for said communication device based on said source; transferring said configuration information over said communication link; and automatically configuring said communication device with said communication (figure 2, paragraph 51). Huotari does not disclose a step of upon determining that configuration information is needed for said communication device, automatically contacting a server via a communication link. However, Dieterman reveals a method of automatically updating network configuration settings including the first step of having the client computer establishes a communication link with the ISP to retrieve the updated

configuration (column 2 lines 65-67, column 3 lines 1-22). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include in Huotari a step of automatically contacting a server when configuration is needed to establish network communication as taught by Dieterman to further reduce user's involvement for a true Plug and Play system.

For all dependent claims below, analysis of claims 7 and 15 is applicable.

- Regarding claim 8, Huotari discloses communication device contacts server via a dial-up modem (paragraph 51).
- With regards to claim 9, Huotari discloses scanning a plurality of database for configuration information (figure 3, paragraph 66).
- Regarding claim 10, Huotari disclose a peripheral computer coupled to communication device contacting the server over communication via dial-up modem (figure 2, paragraph 12).
- Regarding claims 11 and 21, Huotari discloses the communication device automatically configure itself with the configuration information (paragraph 51). The broadband device is interpreted as the user system (computer system and DSL modem) in figure 2.
- Regarding claim 12, Huotari shows a software program in a peripheral computer automatically configuring the communication device with the configuration information (figure 2, paragraph 65).

- Regarding claim 13, analysis of claims 5 and 7 are applicable. When the geographic region of said source is identified for the configuration providing purpose, it would have been obvious to one of ordinary skill in the art at the time of the invention to limit the database scan based on a geographic region of said source of communication.
- With respect to claim 14, Huotari discloses determining configuration information based on the communication device identifier (figure 3, paragraphs 67 and 68).
- With regards to claim 17, Huotari does not disclose the broadband device comprises a stored telephone number with which to contact said server. However, Dieterman discloses the communication device comprises a stored telephone number with which to contact said server (column 3 lines 12-14). It would have been obvious to one with the ordinary skill at the time of the invention to include in Huotari a stored telephone number as taught by Dieterman to automatically connect to the server.
- Regarding claim 18, Huotari reveals logic is operable to automatically configure said broadband communication device with configuration information (figure 2, paragraphs 51 and 65).
- Regarding claim 19, Huotari discloses logic is implemented by software on a peripheral computer couple to said broadband communication device (paragraph 12 and figure 2).
- Regarding claim 20, Huotari shows software is operable to automatically configure broadband communication device upon reception of configuration information (figure 2, paragraph 51).

- Regarding claims 22 and 23, Huotari discloses server is operable to search a database for said configuration information based on customer name and telephone number (paragraph 58).

Response to Arguments

6. Applicant's arguments with respect to claims 1-4, and 6 have been considered but are moot in view of the new ground(s) of rejection.

7. Applicant's arguments filed January 3, 2006 have been fully considered but they are not persuasive.

Applicant argues in page 8 that in the claimed method, the communication device determines that the configuration information is needed and automatically contacts a server via a communication link.

Examiner respectfully disagrees. First of all, as currently recited in line 3 of the independent claim 7 "upon determining that configuration information is needed", herein, claims 7 and 15 do not recite that the configuration information is determined by the communication device; it merely states that determining is needed. Secondly, Dieterman discloses that the client transmits the original telephone number to the ISP computer (claim 10 first element column 8 lines 28-34). By connecting to the ISP using the selected telephone number, the client computer declares its need of configuration

information (new telephone number) as stated, and understood by Examiner, in Dieterman's claim 10. Therefore, Dieterman addresses the claimed limitation.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tito Pham whose telephone number is 571-272-8617. The examiner can normally be reached on 9-6 PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on 571-272-3126. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tqp

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